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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/064,950

09/03/2002

Erin L. Conner

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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT

PAPER NUMBER

3629

NOTIFICATION DATE

DELIVERY MODE

04/08/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/064,950	<b>Applicant(s)</b> CONNER ET AL.	
	<b>Examiner</b> Jonathan Ouellette	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2008 and 19 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,6,11,22-24 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 6, 11, 22-24, and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Request for Continued Examination*

1. The Request filed on 2/19/2008 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/064,950 is acceptable and a RCE has been established. An action on the RCE follows.

### *Response to Amendment*

2. Claims 3, 4, 7-10, 12-21, and 25 have been cancelled and Claim 26 has been added; therefore, Claims 1, 2, 5, 6, 11, 22-24, and 26 are currently pending in application 10/064,950.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1, 2, 5, 6, 11, 22-24, and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Wasilewski et al. (US 2002/0105665 A1).**

5. As per **independent Claims 1 and 26**, Wasilewski discloses a method of transferring a computer file from a first storage media to a second storage media, comprising: reading the file from the first storage media into a third storage media; writing the file from the third storage media into the second storage media; and charging a transaction fee (Fig.5); and establishing a communication link to a portable electronic device through an IR port, an USB port, or a RS-232 port (Figs. 1-3, 5), wherein the first storage media is controlled by the portable electronic device and is in communication with the third storage media through the communication link (Figs. 1-3, 5) (Para 0056, Kiosk can be equipped with peripherals to read digital image files from various sources such as memory cards and portable storage devices like memory sticks – such device require equivalent ports as claimed – and thus would be equivalent to the claimed general peripheral).
6. As per Claim 2, Wasilewski discloses wherein the second storage media is paper (Figs. 1-3, 5).
7. As per Claim 5, Wasilewski discloses establishing a communication link over a computer network to a remote computer, wherein the second storage media is controlled by the remote computer and is in communication with the third storage media over the computer network (Figs. 1-3, 5).
8. As per Claim 6, Wasilewski discloses wherein the computer network is the internet (Figs. 1-3, 5; Para 0009 and 0011).
9. As per Claim 11, Wasilewski discloses determining a transaction type, wherein the first storage media and the second storage media are identified according to the determined transaction type (Figs. 1-3, 5).

10. As per **independent Claim 22**, Wasilewski discloses a system for transferring a computer file from a first storage media, the system comprising: a second media distribution device for distributing a second storage media; a first media read/write interface for coupling to the first storage media; and a payment interface for accepting payment for a transaction in which the computer file is transferred from the first storage media to the second storage media (Figs. 1-3, 5); and a portable electronic device interface, wherein the portable electronic device interface is in communication with the first storage media through an IR port, an USB port, or a RS-232 port (Figs. 1-3, 5) and wherein the first storage media is controlled by a portable electronic device (Figs. 1-3, 5) (Para 0056, Kiosk can be equipped with peripherals to read digital image files from various sources such as memory cards and portable storage devices like memory sticks – such device require equivalent ports as claimed – and thus would be equivalent to the claimed general peripheral).
11. As per Claim 23, Wasilewski discloses wherein the second storage media is paper and the second media distribution device is a digital photocopier (Figs. 1-3, 5).
12. As per Claim 24, Wasilewski discloses wherein the second media is portable electronic media and the second media distribution device is an electronic media distribution device (Figs. 1-3, 5).

### ***Response to Arguments***

13. Applicant's arguments filed 1/22/2008, with respect to Claims 1, 2, 5, 6, 11, 22-24, and 26, have been fully considered but are not persuasive. The rejection will remain as NON-FINAL, based on the cited prior art.

14. The Applicant has made the argument that the cited prior art fails to teach or disclose establishing a communication link to a portable electronic device through an IR port, an USB port, or a RS-232 port (Figs. 1-3, 5), wherein the first storage media is controlled by the portable electronic device and is in communication with the third storage media through the communication link (Figs. 1-3, 5)
15. However, Wasilewski describes a Kiosk that can be equipped with peripherals to read digital image files from various sources such as memory cards and portable storage devices like memory sticks – such device require equivalent ports as claimed – and thus would be equivalent to the claimed general peripheral (Figs. 1-3, 5, Para 0056).
16. Furthermore, the type of port used to connect devices would be non-functional, as the type of connection would have no effect on the business method. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

### ***Conclusion***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization

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where this application or proceeding is assigned (571) 273-8300 for all official communications.

19. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

April 4, 2008

/Jonathan Ouellette/

Primary Examiner, Art Unit 3629